

REMARKS

This is a Response to the Office Action mailed June 26, 2008, in which a three (3) month Shortened Statutory Period for Response has been set, due to expire September 26, 2008. Applicants are requesting a two month extension of time, to expire on November 26, 2008. Claims 8-20 are added. Claims 1-20 are pending. Claims 1-6 are amended.

No new matter has been added to the application. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Examiner Interview

Applicant's representative, Mr. Eric M. Ringer, and Examiner Ana Fortuna conducted telephonic interviews on June 17, 2008, and on June 23, 2008. No agreement was reached.

Allowable Subject Matter

The Examiner has indicated that claims 1-7 would be allowable upon overcoming rejections under 35 U.S.C. §112, second paragraph. Applicant believes that the amended claims and the following discussion obviate the rejection of claims 1-7 under 35 U.S.C. §112, second paragraph. Applicant thanks the Examiner for indicating that the claims contain patentable subject matter, and for at least the reasons stated below, Applicant respectfully submits that claims 1-12 are in condition for allowance.

35 U.S.C. §112, Second Paragraph

Claims 1-7 stand rejected under 35 U.S.C. 112, second paragraph .

MPEP 2171:

Two Separate Requirements For Claims Under 35 U.S.C. 112, Second Paragraph

There are two separate requirements set forth in [35 U.S.C., second] paragraph:

(A) the claims must set forth the subject matter *that applicants regard as their invention*; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

(Emphasis added.)

First Requirement:
Subject Matter Applicant Regards As His Invention

In the Office Action, claims 1-3 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being incomplete for omitting essential steps, and it is alleged that such omission amounts to a gap between the steps; and claims 4-7 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being incomplete for omitting essential structural cooperative relationships of elements, and it is alleged that such omission amounts to a gap between necessary structural connections. The Office Action cites MPEP 2172.01 as authority for the aforementioned rejections.

Under MPEP 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention.” (Emphasis added.) “[E]ssential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.” (Emphasis added.) Applicant respectfully submits that MPEP 2172.01 is directed to determining whether the claim satisfies the aforementioned first requirement of a rejection under 112, second paragraph, *i.e.*, the “claim[] must set forth the subject matter that applicant[] regard[s] as his invention.” MPEP 2171.

A rejection based on the failure to satisfy this requirement [i.e., the claim must set forth the subject matter that applicant regards as his invention,] is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

MPEP 2172, emphasis added.

Applicant has not described in the specification or in other statements of record that the elements and steps recited by the Examiner are essential or necessary. Further, “it is not necessary that a claim recite each and every element needed for the practical utilization of the

claimed subject matter.” *Bendix Corp. v. United States*, 600 F.2d 1364, 1369. See *Ex Parte Trummer et al.*, Board of Patent Appeals and Interferences, Appeal No. 1997-1351 (the fact that the disclosure disclosed an element does not necessarily render it essential or imply claimed invention is inoperative without the element). For at least the reasons above, Applicant respectfully requests that the aforementioned rejections be withdrawn.

Second Requirement: Claim Clarity

Claims 1-7 stand rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

Applicant has amended claims 1-7 and respectfully submits that the pending claims are not indefinite. Therefore, Applicant respectfully requests that the rejection of claims 1-7 be withdrawn.

Claim Amendments

Claims 1-7 have been amended to correct informalities

Pressure Booster

Independent claims 1 and 4 have been amended to recite, inter alia, a “pressure booster having a piston, a pressure chamber, and a pressure reservoir.” In the event of a subsequent Office Action that may object to the term “pressure booster,” Applicant respectfully submits that there is no *haec verba* requirement.

“The subject matter of the claim need not be described literally ... in order for the disclosure to satisfy the description requirement.” MPEP 2163.02. “The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.’ Under *Vas-Cath, Inc. v. Mahurkar*, ... to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the

invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’ ... [T]he fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” MPEP 2163.02 (internal citations omitted).

New Claims

Claims 8-20 are added.

Claims 8-11 depend from independent claim 4, and claim 12 depends from independent claim 1. For at least the reason that independent claims 1 and 4 are allowable, claims 8-12 are also allowable.

Newly added independent claims 13 and 17 correspond generally to independent claims Mr. Ringer and Examiner Fortuna discussed in their aforementioned interviews and include limitations suggest by Examiner Fortuna. Claims 14-16, which depend from claim 13, correspond generally to claims 2, 3 and 12, respectively. Claims 18-20, which depend from claim 17, correspond generally to claims 5-7, respectively.

Stated Reasons For Allowance

The Office Action states that “combining membrane separation with the double piston arrangement is recognized by Applicant to be old, see also U.S. Patent 7,189,325 to same applicant which priority goes back to 11/2000” (emphasis added).

With the exception of U.S. Patent 7,189,325, Applicant respectfully requests, for clarity of the record, that the Examiner indicate when/where Applicant has recognized combining membrane separation with a double piston arrangement is old. In the event that the Examiner is relying on Applicant’s discussion of WO 02/41979 at page 1 of Applicant’s disclosure, Applicant respectfully notes that WO 02/41979 is the PCT publication of PCT/EP01/08271 and that U.S. Application 10/432,498, which issued as U.S. Patent 7,189,325, was the national application of PCT/EP01/08271. In other words, Applicant was describing U.S. Patent 7,189,325 in Applicant’s discussion of WO 02/41979.

CONCLUSION

In light of the above amendments and remarks, Applicant respectfully submits that all pending claims are allowable. Applicant, therefore, respectfully requests that the Examiner reconsider this application and timely allow all pending claims. If the Examiner notes informalities in the claims, he is encouraged to contact Mr. Ringer by telephone to expediently correct such informalities.

Respectfully submitted,
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